



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,144	12/29/2003	Daniel M. Gorman	DX01170K1	4801
24265 7590 04/01/2008 SCHERING-PLOUGH CORPORATION PATENT DEPARTMENT (K-6-1, 1990) 2000 GALLOPING HILL ROAD KENILWORTH, NJ 07033-0530				
EXAMINER				
JIANG, DONG				
ART UNIT		PAPER NUMBER		
1646				
MAIL DATE		DELIVERY MODE		
04/01/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action **Before the Filing of an Appeal Brief**

Application No.

10/749,144

Applicant(s)

GORMAN, DANIEL M.

Examiner

DONG JIANG

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 March 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 33-35

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(a).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet

12. ☒ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). 3/10/08

13. ☐ Other: _____

Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejection of claims 33-35 under 35 U.S.C. 112, second paragraph, as being indefinite, in view of applicants argument.

Continuation of 11, does NOT place the application in condition for allowance because:

Claims 33-35 remain rejected under 35 U.S.C. 102(a) as being anticipated by Chen et al., US6,569,645, for the reasons of record set forth in the previous Office Actions mailed on 6/1/07 and 1/8/08.

Applicants argue, in the response filed on 3/10/08, that Chen does not clearly and unambiguously disclose use of antibodies that inhibit IL-17C to treat psoriasis; and that, while psoriasis is mentioned, the reference generally refers to all IL-17 cytokine and receptor polypeptides and to all antibodies to these polypeptides for treating any one of a laundry list of diseases, which represent a staggering number of permutations of potentially therapeutic compounds and diseases, thus, there is no way for the skilled artisan reading these passages to see any clear teaching of which "compound of the invention" would be useful to treat which immune-related disease, let alone a clear teaching of treating psoriasis using antibodies that inhibit IL-17C. Applicants further argue that while Chen teaches that IL-17 "may contribute to" psoriasis, the reference also teaches that IL-17 and IL-17C have "differential" activities; that, in contrast to the present application, Chen does not disclose expression of IL-17C in any disease tissue, let alone elevated expression of IL-17C in psoriasis skin as compared to normal skin; that due to the long list of "immune-related" diseases mentioned in the application for which any of the IL-17 cytokine family members, or any of the IL-17 family receptors, or any agonists thereof, or any antagonists thereof, "may be used to treat", Chen fails to enable a method of using an antibody that inhibits IL-17C to treat psoriasis as it would constitute undue experimentation to determine which of these compounds would be useful to treat which of these diseases. Applicants argument has been fully considered, but is not persuasive for the following reasons: according to MPEP (§2121), "when the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability. In re Sasse, 629 F.2d 675, 207 USPQ 107 (CCPA 1980)". In the instant situation, although the recited disease/condition being treated is in the "laundry list", it is, nonetheless, expressly taught by the prior art reference. Applicants have provided no factual evidence that the method of treating the same condition taught by the prior art reference would not be enabled. Further, "a reference is not limited to the disclosure of specific working examples" (In re Mills, 470 F.2d 649, 651, 176 USPQ 196, 198 (CCPA 1972)).